

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application:

P. Beswick, et al.

Serial No.: 10/527,799

Examiner: Morris, P.

Filing Date: August 17, 2005

Art Unit: 1625

For: COX-2 INHIBITING PYRIDINE DERIVATIVES

Assistant Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is a Response to the Office Action dated 24 October 2006. The Office Action requires an election under 35 USC 121 and 372.

The Examiner has required restriction between the following groups:

Group I, instances wherein Y is CH, A, R¹ and R² together represent non-heterocyclic groups,

Group II, the instances wherein Y is N, A, R¹ and R² together represent non-heterocyclic groups,

Group III, any compound not grouped in Groups I and II,

Group IV, Claim 7, drawn to multiple processes, and

Group V, Claims 10, 11, 14, 15, 17-19, and 21-26, drawn to multiple uses.

Applicants hereby provisionally elect with traverse to prosecute the claims of Group I. According to the Restriction Requirement, Applicants are requested to elect one method of use and one process of preparing in the event of an election of Group I. Therefore, Applicants elect the method of treating rheumatoid arthritis (Claim 17) and the process of preparing compounds recited in Claim 7.

The above election is made with traverse. Specifically, the genus of claim 1 has not been shown to lack a special technical feature under PCT Rule 13.2. The genus of claim 1 is written in Markush format. When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature [i.e. special technical feature] where the following criteria are fulfilled: (a) all alternatives have a common property or activity, and (b)(1) a common structure is

present. MPEP 1850(III)(B). Here, the compounds of claim 1 have a common activity as inhibitors of Cox-2, and have the common structure of formula (I) shown in claim 1.

No references are currently cited as novelty destroying against the recited genus, and no references were cited as novelty destroying against the recited genus in the corresponding international application (see IPER of PCT/EP03/11065). The required restriction of compound (I) between Groups I, II, and III, is merely arbitrary, not supported by prior art, and is therefore not made in accordance with PCT 13.1 and 13.2. Thus, the genus of claim 1 should be presumed to have unity of invention.

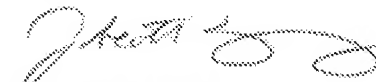
Applicants also traverse the requirement limiting the method of treatment claims to one specific "disease". Here, the method of treating conditions mediated by Cox-2 is a special technical feature of the compounds. The specifically identified conditions are subcategories of those conditions, and should be included as methods of use allowed under 37 CFR 1.475(b)(3).

Applicants expressly reserve the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions in the remaining claims.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge any fees or credit any overpayment, particularly including any fees required under 37 CFR Sect 1.16 or 1.17, and any necessary extension of time fees, to deposit Account No. 07-1362.

Applicants respectfully submit that the instant application is in condition for allowance, which action is respectfully requested. The Examiner is invited to contact the undersigned at (919) 483-8160, to discuss this case, if desired.

Respectfully submitted,



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